

## **REMARKS**

The Applicant has carefully reviewed the Final Office Action mailed February 2, 2010 (hereinafter "Office Action") and offers the following remarks.

Claims 7 and 15 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Patent Office opined that the claims contain subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant respectfully traverses the rejection.

The Applicant submits that the claims comply with 35 U.S.C. § 112, first paragraph. As pointed out by the Patent Office, if "alternative elements are positively recited in the specification, they may be explicitly excluded in the claims."<sup>1</sup> Throughout the originally filed application, such as Figures 2-10 and the accompanying description, discussion is made regarding a digital camera 110, the various components of the digital camera 110, and the operation of the digital camera 110, which both the Examiner and the BPAI has equated with a scanner.<sup>2</sup> Thus, according to the Patent Office, a digital camera is the same thing as a scanner. The Applicants submit that as the Specification clearly recites a digital camera, which the Patent Office has equated with a scanner, then the Applicants are entitled to explicitly exclude a scanner in the claims.

In addition, the Applicant submits that the Applicant is entitled to disclaim something that may arguably fall within the broadest reasonable interpretation of the claims. By reciting that the image capture device is not a scanner, the Applicant is merely pointing out that the claim does not cover a scanner in order to avoid an overly broad interpretation of the pending claims when viewed in light of the Specification.

Moreover, according to Chapter 2163 of the M.P.E.P., while "there is no in haec verba requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure." In addition, as the Court of Appeals for the Federal Circuit has recently held, "the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon

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<sup>1</sup> See Final Office Action mailed February 2, 2010, page 4.

<sup>2</sup> See Final Office Action mailed February 2, 2010, pages 3-5 and BPAI Decision on Appeal decided on March 9, 2009, page 6.

reading the specification that the new language reflects what the specification shows has been invented.”<sup>3</sup> The Applicant submits that the feature of an image capture device not being a scanner is both implicit and inherent in the Specification as originally filed. As noted above, the Specification discusses a digital camera 110, the various components of the digital camera 110, and the operation of the digital camera 110. The Applicant submits that as the Specification and the Figures disclose a digital camera, it is inherent that an image capture device is not a scanner. More specifically, as the Specification explicitly discloses a digital camera 110, it necessarily flows that the image capture device cannot be a scanner.

The Applicant also submits that, as the Specification and the Figures disclose a digital camera, it is implicit that an image capture device is not a scanner. In particular, as the Specification explicitly discloses a digital camera 110, one skilled in the art would reasonably infer that the image capture device is not a scanner. For at least this reason and the reasons noted above, claims 7 and 15 comply with the written description requirement under 35 U.S.C. § 112, first paragraph, and the Applicant requests that the rejection be withdrawn. Likewise, claims 8, 9, 11-14, 16-18, and 20-22, which depend from either claim 7 or claim 15, are patentable for at least the same reasons.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact the Applicant’s representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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<sup>3</sup> See *All Dental Prods LLC v. Advantage Dental Prods.*, 309 F.3d 774 at 779 (Fed. Cir. 2002) (citing *Eiselstein v. Frank* 52 F.3d 1035, 1039 (Fed. Cir. 1995)).